

DETAILED ACTION

1. This Office Action is in response to Applicant's Amendment filed March 7, 2011. Claims 77-108 are currently pending in this case. Claims 77, 78, and 85, are currently amended, although claim 85 stands previously withdrawn. Claims 85-108 were previously withdrawn. Accordingly, Claims 77-84 are under examination.

Response to Arguments

2. Applicant's arguments filed March 7, 2011 have been fully considered but they are not persuasive.

3. Applicant argues, regarding the section 112, 2nd paragraph rejection of claims 77-84, as currently amended, that the claims, as amended, no longer recite a device and steps for its use.

4. Examiner respectfully disagrees. In this case, claims 77 and 78 recite a system or device as well as steps for its use. Note the recitation "a control unit . . . causes a complete generation such that the media generator stores . . . and the packaging generator produces . . ."

5. Further, claims 77 and 78 recite both structure "an electronic . . . system" and various generators and control units or modules which under the broadest reasonable interpretation of the claims are likely software. Thus it is unclear whether claims 77 and 78 are hardware, software or some combination thereof.

6. Applicant argues, regarding claim 77 and 78 that the cited references do teach, suggest or disclose a release unit and a generator located at a local site.

7. Examiner respectfully disagrees. While Dolphin at figure 1 shows the various components as separate, the said components are not necessarily remote, but rather may be communicating via, e.g. a local area network, which by definition (local area network) makes

Art Unit: 3685

them all located at a same local site. Further, it would be a predictable result for one of ordinary skill in the art to relocate remote components to the same location, motivated by the need for greater convenience, for a more ergonomic workplace, or for greater economy in transportation of personnel. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 77-84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved. *IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990). A single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention. *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990).

11. In this case, claims 77 and 78 recite a system or device as well as steps for its use. Note the recitation "a control unit . . . causes a complete generation such that the media generator stores . . . and the packaging generator produces . . .", also "'such that: the media generator stores..." and "wherein said control unit also prevents..."

Art Unit: 3685

12. Further, claims 77 and 78 recite both structure “an electronic . . . system” and various generators and control units or modules which under the broadest reasonable interpretation of the claims are likely software. Thus it is unclear whether claims 77 and 78 are hardware, software or some combination thereof.

13. For these reasons, independent claims 77 and 78 and their dependent claims 79-84 are rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 77-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolphin (US 5,457,746) in view of Katz et al (US 5,926,624).

16. Regarding claims 77 and 78 –

17. Dolphin discloses an electronic digital media production system for manufacturing on physical media and on demand at a local site a selected digital information product selected by a customer at the local site after a licensing control center located remotely from the local site provides an electronic release code authorizing the on demand manufacturing of the selected digital information product at the local site to the physical media, the system comprising:

a mass data storage device located at the local site and which stores digital information of a plurality of different digital information products including the selected digital information product; (col 22 n 55-56, fig2/31)

Art Unit: 3685

a release unit located at the local site and which has a user interface and an output, said release unit: (col 4 ln 55-67)

permits selection of the selected digital information product from among the plurality of different digital information products stored on the mass data storage device by receiving a request via the user interface from the customer to manufacture on demand at the local site the selected digital information product to the physical media, (col 4 ln 55-67) and

issues, via the output, the request as a product release request to the licensing control center; (col 5 ln 7-16)

a media generator located at the local site; col 5 ln 7-16

and

a control unit located at the local site and which controls both the media generator and the package generator, said control unit in response to receiving an electronic release code, which is both unique to and provided only for the selected digital information product by the licensing control center in response to receiving the product release request to authorize the on demand manufacturing of the selected digital information product at the local site to the physical media, causes a complete generation such that the media generator stores on the physical media the digital information of the selected digital information product from the mass data storage device as well as to record on the physical media the issued unique electronic release code for the selected digital information product, (col 5 ln 7-16)

18. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21,

Art Unit: 3685

distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

19. Katz discloses, as Dolphin does not, preventing complete generation of any digital information product before receipt of the unique electronic release code issued by the remote licensing control center (col 11 ln 32 – col 12 ln 16, where processing only continues if both systems are authorized systems).

20. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Dolphin and Katz in order to prevent unauthorized usage of digital media by employing a license on a remote server.

21. Regarding claim 79 –

22. Dolphin discloses a unique electronic release code includes a license number, and in which the packaging generator is arranged to print at least one of the license number and name of the customer which selected the selected digital information product onto the media packaging. (col 5 ln 40-45, col 5 ln 57-60).

23. Regarding claim 80 –

24. Dolphin does not specifically teach wherein the unique release code includes a license number; and in which there is further included a certificate of authenticity generator arranged to generate a certificate of authenticity including at least one of the license number and the customer's name. However, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-

Art Unit: 3685

20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer’s name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

25. Regarding claim 81 –

26. Dolphin suggests wherein a media generator is arranged to include a user-defined personalization applied to at least one of the surface of the media, and the digital information stored on the media. (Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result to somehow make the CD-ROM suitable for mailing via US mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)., Where the container, would include , *inter alia*, the recipient's address and name, both of which are defined by the user. Also, e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and thus would likely include such identifying information as license numbers, names, addresses, etc).

27. Regarding claim 82 –

Art Unit: 3685

28. Dolphin discloses wherein a media generator includes a media writer. (e.g. col 4 ln 25-30, how else to store data on a CD-ROM and the send it away by U.S. mail if not by media writer of one sort or another?).

29. Regarding claim 83 –

30. Dolphin discloses wherein the product release code includes a license number, and in which the media generator includes a printer arranged to print onto a surface associated with the selected digital information product at least one of the license number and the customer's name. (e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and thus would likely include such identifying information as license numbers, names, addresses, etc. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Such container would normally include providing some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name, both of which are defined by the user. Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or

Art Unit: 3685

“license”. It would be a predictable result to attach a customer’s name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

31. Regarding claim 84 –

32. Dolphin discloses wherein the request from the customer also includes details concerning personalized information of the customer received via the user interface, and the product release request further includes data representing the personalized information, and in which the control unit is responsive to the data representing the personalized information by causing the media generator to include the personalized information in the physical media for the selected digital information product. (Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer’s name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

Conclusion

33. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

34. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3685

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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